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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,242	02/24/2004	Nodoka Oishi	04025	1223

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EXAMINER	
LANDAU, MATTHEW C	
ART UNIT	**PAPER NUMBER**
2815	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/784,242	OISHI ET AL.	
	Examiner	Art Unit	
	Matthew Landau	2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *5,7-9 and 13-15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6 and 10-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Invention I (claims 1-14) and Species I (claims 1-6 and 10-12) in the reply filed on June 29, 2005 is acknowledged.

A quick review of the drawings reveals that claim 5 does not read on the elected species. The limitation "a terminal on an underside of the light emitting chip" is shown in Figure 6, which corresponds to Species V. Therefore, claims 5, 7-9, and 13-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 10, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto et al. (US PGPub 2004/0065894, hereinafter Hashimoto).

Regarding claims 1-3, Figure 1 of Hashimoto discloses a light emitting element comprising: a base 11 made of a heat conductive material (metal) and having a heat radiation surface (bottom surface) formed on a surface thereof; at least one wire plate 12 made of an insulating material (glass epoxy) (paragraph [0048]) and secured to an upper surface of the base;

exposing means (hole 13 formed in wiring plate 12) (paragraph [0052]) for forming an exposed mounting area on the surface of the base; conductive patterns 12a formed on the wire plate; a light emitting chip 1 secured to the base at the mounting area; and connecting means W for electrically connecting the light emitting chip to the conductive patterns.

Regarding claim 4, Figure 1 of Hashimoto discloses the connecting means comprises a plurality of lead wires W.

Regarding claim 6, Figure 1 of Hashimoto discloses an encapsulating member 50 for protecting the light emitting chip 1.

Regarding claim 10, Figure 12 of Hashimoto discloses a base 11 made of heat conductive material and having a flat plate shape and a heat radiation surface (bottom surface) formed on a surface thereof; at least one wire plate 12 made of an insulation material (glass epoxy) (paragraph [0048]) and secured to an upper surface of the base; exposing means (hole in plate 12) for forming an exposed mounting area on the surface of the base; conductive patterns 12a secured to the wire plate; a light emitting chip 1 secured to the base at the mounting area; connecting means W for electrically connecting the light emitting chip to the conductive patterns; a print substrate 70 having conductive patterns 71/73 provided on an underside thereof and secured to the conductive patterns on the wire plate so as to electrically connect both the conductive patterns (paragraph [0111]). In order to connect with the conductive patterns 12a, the conductive wiring in through hole 73 must be at least partially on an underside of the printed substrate 70.

Regarding claim 11, Figure 12 of Hashimoto discloses the print substrate 70 has a hole for discharging the light emitted from the light emitting chip 1.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Takine (US PGPub 2005/0073846).

Regarding claims 1-3, Figure 5 of Takine discloses a light emitting element comprising: a base 22/51 made of a heat conductive material (paragraph [0064]) and having a heat radiation surface 52 formed on a surface thereof (bottom surface); at least one wire plate 25 made of an insulating material (paragraph [0040]) and secured to an upper surface of the base; exposing means (hole formed in wiring plate 25) (paragraph [0040]) for forming an exposed mounting area on the surface of the base; conductive patterns 26 formed on the wire plate; a light emitting chip 27 secured to the base at the mounting area; and connecting means 28 for electrically connecting the light emitting chip to the conductive patterns.

Regarding claim 4, Figure 5 of Takine discloses the connecting means comprises a plurality of lead wires 28.

Regarding claim 6, Figure 5 of Takine discloses an encapsulating member 29 for protecting the light emitting chip 27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Takine.

Regarding claim 12, the difference between Hashimoto is a heat radiating member secured to an underside of the base. Figure 5 of Takine discloses a heat radiating member 52 secured to an underside of a base 51/22 of an LED package. In view of such teaching, it would have been obvious to the ordinary artisan at the time the invention was made to modify the invention of Hashimoto by including a heat radiating member secured to an underside of the base for the purpose of improving the efficiency of heat dissipation (paragraph [0066] of Takine).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Landau whose telephone number is (571) 272-1731.

The examiner can normally be reached from 8:30 AM - 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (571) 272-1664. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should any questions arise regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew C. Landau

Examiner

July 8, 2005

JEROME JACKSON
PRIMARY EXAMINER